

## **REMARKS**

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, tentatively rejected all claims 1-21. In response, Applicant has submitted the foregoing amendment and the following distinguishing remarks. Applicant respectfully requests reconsideration and withdrawal of the rejections for at least the following reasons.

### **Response to Claim Objections**

The Office Action objected to claim 14 because it was a system claim dependant from a method claim. Applicant has amended claim 14 to depend from claim 11 (a system claim), instead of claim 1. Accordingly, the objection to claim 14 should be withdrawn.

### **Response to Rejections under 35 U.S.C. 112**

The Office Action rejected claims 16-21 under 35 U.S.C. § 112, second paragraph. This rejection was based on language of claim 16, which was unclear to the Examiner. In response, Applicant has amended this claim to define that the route information comprises a record of a plurality of tools.

### **Discussion of Claim Rejections**

Claims 1, 6 and 11 are rejected under U.S.C. 102(b) as allegedly being anticipated by Borders et al. (US Patent. No. 7,139,721). Claims 2-5, 7-10 and 12-15 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Borders in view of Greene (Production and Inventory Control Handbook, published 1997). Applicant respectfully

requests reconsideration and withdrawal of these rejections for at least the following reasons.

Amendments are made to claim 1 to incorporate the subject matter of claims 2 and 3. Claims 2 and 3 are correspondingly cancelled. In addition, amendments are made to claim 6 to incorporate the subject matter of claims 7 and 8. Claims 7 and 8 are correspondingly cancelled. Similarly, amendments are made to claim 11 to incorporate the subject matter of claims 12 and 13. Claims 12 and 13 are correspondingly cancelled. The amendments of claims 1, 6 and 11 further distinguish the claimed invention from the cited reference.

Among these rejected claims, claims 1, 6, and 11 are independent. Claims 6 and 11 are rejected on the same basis as claim 1. Therefore, remarks are provided regarding to patentability of the independent claim 1. The amendment to claim 1 renders the rejection of that claim moot. Instead, the rejections of original claims 2 and 3 are now relevant to independent claim 1, and those rejections will be addressed below.

The Office Action (pages 3 and 5) states that Borders teaches the step of "acquiring historical customer delivery data of a plurality of customers" of claim 1 (see Borders, col. 15, lines 4-8). In addition, the Office Action (page 5) states that the "delivery time requirements" are part of historical purchasing data (see Greene). In addition, the Office Action states that Borders discloses the step of "reserving production capacity for the customers in accordance with the different categories" (see col. 16, lines 41-54). Furthermore, the Office Action (page 5) states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use delivery time

requirements in the invention of Borders to provide more insight in the need and frequency for which a commodity will be purchased.

Accordingly, based on the Office Action and the cited language, the 'order history' taught by Borders is interpreted to disclose the "historical customer delivery data" of claim 1, and the "delivery time requirements" are seen as part of the historical purchasing data. The Office Action, therefore, regards that it would have been obvious to use "delivery time requirements" in the invention of Borders to provide more insight in the need and frequency for which a commodity will be purchased.

Applicant notes that, the proposed modification of the applied references CANNOT arrive at the claimed subject matter. In this regard, according to the proposed modification stated in the Office Action, the "delivery time requirements" are used in the invention of Borders. Based on the teachings of Borders, the proposed modification provides methods and apparatus for scheduling delivery of an order via a wide area network.

In addition, the Office Action states that Borders discloses the step of "reserving production capacity for the customers in accordance with the different categories" (see col. 16, lines 41-54). The so-called 'capacity allocation history screen 1000' and 'target capacity allocation 1014' (col. 16, lines 41-54; col. 17, lines 24-29), however, have nothing relevant to do with the "production capacity." Accordingly, the proposed modification of the applied references CANNOT arrive at the claimed subject matter. For at least this reason, the rejection of claim 1 should be withdrawn.

In addition, there is no reason to use "delivery time requirements" of the invention of Borders, since the "delivery time requirements" (which are "selected from the group consisting of fixed delivery time requirements, distributed delivery time requirements, and

floating delivery time requirements” do not provide more insight in the need and frequency for which a commodity will be purchased.

According to Borders (col. 15, lines 4-39), the ‘customer point value’ is determined by summation of points based on factors such as shipment size and shipment frequency; and the factors are used to characterize ‘a level of customer activities’. In other words, using the language of the Office Action, the factors are used to characterize ‘need and frequency for which a commodity will be purchased’.

In contrast, the “delivery time requirements” of claim 1 are “selected from the group consisting of fixed delivery time requirements, distributed delivery time requirements, and floating delivery time requirements.” To one of ordinary skill in the art, “delivery time requirements selected from the group consisting of fixed delivery time requirements, distributed delivery time requirements, and floating delivery time requirements” do not provide more insight in the need and frequency for which a commodity will be purchased. For at least this additional reason, teachings of Borders and Greene do not suggest all features of the claim 1 to one of ordinary skill in the art. The proposed modification of the applied references CANNOT arrive at the claimed subject matter. That is, even if Borders and Green could be properly combined, the resulting combination does not disclose the combination of features of claim 1. Accordingly, the rejection of claim 1 should be withdrawn.

As a separate and independent basis for the patentability of claim 1, Applicant submits that the combination of Borders and Greene is improper and therefore does not render the claims obvious. In this regard, the Office Action combined Green with Borders

to reject the claims on the solely expressed basis that “it would have been obvious ... to provide more insight in the need and frequency for which a commodity will be purchased.” (see e.g., Office Action, p. 5)

This rationale is both incomplete and improper in view of the established standards for rejections under 35 U.S.C. § 103.

In this regard, the MPEP section 2141 states:

The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966))... As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Ascertaining the differences between the claimed invention and the prior art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

In addition:

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

As reflected above, the foregoing approach to obviousness determinations was recently confirmed by the United States Supreme Court decision in *KSR INTERNATIONAL*

CO. V. TELEFLEX INC. ET AL. 550 U.S. 1, 82 USPQ2d 1385, 1395-97 (2007), where the Court stated:

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17–18.

Indeed, as now expressly embodied in MPEP 2143, “[t]he **key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious**. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (*Emphasis added, MPEP 2143*). “Objective evidence relevant to the issue of obviousness **must** be evaluated by Office personnel.” (*MPEP 2141*). “The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*MPEP 2141*).

Simply stated, the Office Action has failed to at least (1) ascertain the differences between and prior art and the claims in issue; and (2) resolve the level of ordinary skill in the art. Furthermore, the alleged rationale for combining the references is merely an improper conclusory statement that embodies clear and improper hindsight rationale. As noted above, the alleged motivation for combining Greene with Borden was “to provide more insight in the need and frequency for which a commodity will be purchased.” As such, the Office Action fails to set forth the required objective indicia appropriate to support the rejection.

For at least these additional reasons, Applicant submits that the rejections of claim 1 is improper and should be withdrawn.

On the same basis as claim 1, rejections of claims 6 and 11 should be withdrawn. Insofar as claims 2-5, 7-10 and 12-15 depend from claims 1, 6, and 11, respectively, these claims define over the cited art for the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

#### **Response to Rejections of claims 16-21**

Claims 16-21 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Borders in view of Shekar et al. (US Publication 2003/0208392). Applicant respectfully requests reconsideration and withdrawal of these rejections for the following reasons.

### **Borders does not disclose the route information for the product**

The Office Action (page 8) states that Borders teaches "a capacity model having route information for the product, wherein the route information records a plurality of tools" of claim 1. In the cited paragraph, Borders discloses 'delivery information'. According to Borders, the 'delivery information' is, for example, vehicle delivery routes, stops, etc. In the contrast, according to claim 1, the "route information comprises a record of a plurality of tools records a plurality of tools". To one of ordinary skill in the art, 'delivery information' does not disclose "route information comprises a record of a plurality of tools records a plurality of tools".

For at least this reason, teachings of Borders and Shekar do not suggest all features of the claim 16 to one of ordinary skill in the art. Accordingly, the rejection of claim 16 should be withdrawn. Insofar as claims 17-21 depend from claim 16, the rejections of these claims should be withdrawn for at least the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **CONCLUSION**

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.



No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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& RISLEY, L.L.P.**

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